

REMARKS

The applicant has carefully considered the official action dated March 16, 2006, and the references it cites. Claims 1, 5, and 9-11 have been amended. Claims 12-20 have been added. In view of the following remarks, the applicant respectfully submits that pending claims 1-20 are in condition for allowance. The applicant respectfully requests reconsideration of this application.

The Rejections under 35 U.S.C. § 112

Claims 10 and 11 were rejected under 35 U.S.C. § 112 as being indefinite because of a perceived insufficient antecedent basis resulting from references to prior steps listed in the claim from which claims 10 and 11 depend. The claims have been rewritten in accordance with the Examiner's preference. Thus, any indefiniteness that may have existed has been eliminated.

The Rejections under 35 U.S.C. § 102

Claims 1-3, 5-7 and 9 have been rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent 5,956,693 ("Geerlings"). The applicant respectfully traverses these rejections.

As recited in the present application, independent claim 1 is generally directed toward a method of adding a targeted advertisement to a periodical. In particular, claim 1 comprises a method of creating two brochure templates with variable print fields. Each printed first brochure version includes personalized information unique to a subscriber to whom the printed brochure is addressed. The information was gathered from a subscriber list. Also, the brochure is sent attached the periodical to which the subscriber subscribes. Independent claim 5 is also related to attaching targeting advertisements to a periodical in which at least two databases of information are accessed during practice of the method. In addition, claim 9 is also similar but generally related to targeted financial product or service promotions.

Geerlings is directed generally to merchant-to-customer communications in which the customers are grouped according to various characteristics. However, in Geerlings, the documents that are targeted for the customers are form letters, attachments/brochures and electronic documents that are transmitted across designated communications channels (e.g., facsimile, mail, E-mail, on the Internet, Website, etc.). See Geerlings Col. 14, lines 18-47. Geerlings never describes targeted promotional materials that are attachments to the periodicals to which the subscriber subscribes, and this is an important distinction. While Geerlings describes personalized communications from a merchant to a customer, Geerling does not describe anything more than additional and most likely wholly unsolicited communications from a merchant, i.e., “junk mail.”

Contrarily, the present claims recite targeted promotional materials that are based in part on information from a subscriber list about subscribers of a periodical that are included in copies of the very periodical to which the subscribers subscribe. That is, the present disclosure teaches the inclusion of targeted promotional materials where the targeted information includes subscriber information and the promotional material is included with the product to which the subscriber subscribes. The promotional material is less likely to be dismissed by the subscribers as “junk mail” when the promotional is attached to the product or service to which the subscriber subscribes. Increased exposure may directly increase the effectiveness of the advertising/promotional campaign. Geerlings simply does not disclose at least accessing a subscriber list of subscribers to the periodical or attaching the first and second printed brochure versions to respective copies of the periodical to which the subscriber subscribes.

Consequently, Geerlings does not disclose all of the claim recitations present in claims 1, 5, and 9. Because Geerlings does not have all the elements of the claims discussed herein, Geerlings does not anticipate claims 1, 5 and 9 and all their dependents. In particular,

it is well established that “[a] claim is anticipated only if each and every elements as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

Accordingly, claims 1, 5, 9, and all claims dependent thereon are in condition for allowance.

The 35 U.S.C. § 103 Rejections

Claims 4, 8 and 10-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Geerlings. The applicant respectfully traverses these rejections.

As discussed above, Geerlings at least fails to describe accessing a subscriber list of subscribers to the periodical or attaching the first and second printed brochure versions to respective copies of the periodical to which the subscriber subscribes, and it would not be obvious to modify Geerlings to do so. Therefore, the combinations used as the bases for the obviousness rejections do not teach or suggest all of the claim recitations. No combination of the cited portions of the prior art suggests accessing a subscriber list of subscribers to the periodical or attaching the first and second printed brochure versions to respective copies of the periodical to which the subscriber subscribes. It is well recognized that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. 2143.03. “All of the words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Consequently, the obviousness rejection for claims 7, 8 and 10-11 cannot stand and the claims are in condition for allowance

New Claims

New claims 12-17 depend from one of claims 1, 5, or 9. No new matter has been entered. As established above, Geerlings does not anticipate claims 1, 5, 9 and any claims dependent therefrom. Thus, new claims 12-17 are in condition for allowance.

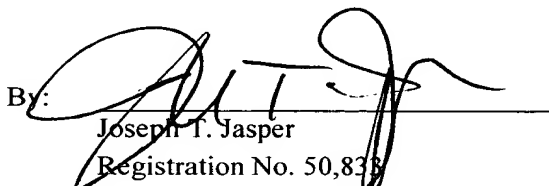
New claims 18-29 do not introduce new matter. These new claims generally recite brochures and methods of making brochures that are attached to a periodical that include cover sheets and second sheets or inserts. Geerlings fails to describe a brochure attachment or a method of making a brochure attachment to a periodical that includes a cover sheet that is exposed to view for mailing of the periodical and at least one insert sheet attached to an inside page of the cover sheet. For at least these reasons, Geerlings does not anticipate claims 18-29, and therefore, claims 18-29 are in condition for allowance. Please note that independent claim 18 is similar to issued claim 1 in related U.S. Patent 6,276,724, which has been incorporated herein by reference in its entirety. In addition, please note that independent claim 24 is similar to issued claim 1 in related U.S. Patent 6,129,346, which has also been incorporated herein by reference in its entirety.

Conclusion

Based on the foregoing remarks, it is respectfully submitted that all claims are in condition for allowance. If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

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